Remarks

Claims 1 and 20 are amended herein.

35 USC § 112

The Office Action rejected the claims for lack of enablement. Enablement merely requires that the specification provide "sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. " MPEP 2164.01. If Applicants understand the rejection correctly, it appears that the Office believes the claims are too broad to be enabled because the specification allegedly does not provide enough examples of therapeutically active compounds that would work, and thus undue experimentation would be required.

First, the Office incorrectly characterizes the breadth of the claims by referring to the term, "an agent," which is infinitely broad instead of the actual claim language "a therapeutically active agent" which is not infinitely broad. Second, the specification cites about 400 different examples of therapeutically active agents. (See p. 6, line 22 to p. 15, line 15.) Thus, a broad scope of the "how to make" requirement is satisfied.

Applicants have shown that cyclodextrin and cyclodextrin derivatives deliver prednisolone to the back of the eye. While the mechanism of this delivery is not known, it is reasonable to hypothesize that it is related to the ability of cyclodextrin and cyclodextrin derivatives to complex lipophilic compounds and/or form inclusion compounds. As pointed out by the Office, combinations of drugs and cyclodextrins or cyclodextrin derivatives have been studied extensively. Thus, the known literature provides ample guidance to a person of ordinary skill to determine which compounds are likely to work in the claimed methods.

The Office appears to believe that the "how-to-use" requirement makes it necessary for Applicants to do extensive testing of the claimed compounds in order for the enablement requirement to be satisfied. This is contrary to established law.

> Early filing of an application with its disclosure of novel compounds which possess significant therapeutic use is to be encouraged. Requiring specific testing of the thousands of…analogs encompassed by the present claim in order to satisfy the how-to-use requirement of § 112 would delay disclosure and frustrate, rather than further, the interests of the public. In re Bundy, 642 F.2d 430, 434 209 USPQ 48, 52 (C.C.P.A. 1981).

Applicants have discovered a method that avoids the significant unpleasantness of using a needle or surgery to administer a drug to the back of the eye, or having high systemic concentrations of a drug. Thus, to further public interest, filing does not require "specific testing of thousands of" compounds as the Office appears to believe is necessary.

Finally, although Applicants have shown that the invention works, enablement does not require that the inventor provide evidence that the invention works: "lack of evidence that the claimed invention works as described should never be the sole reason for rejecting the claimed invention on the grounds of lack of enablement." MPEP 2164.02. "[I]t is incumbent upon the Patent Office,

whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." MPEP 2164.04

Thus, if the Office doubts that the claimed method works, it has the burden of supplying acceptable evidence or reasoning to support this doubt before an enablement rejection can be made. Since such evidence has not been provided, the claims should be presumed to be enabled. Therefore, the enablement rejection was improper.

35 U.S.C. § 102

Claims 1-15 and 19-27 were rejected as being anticipated by Guy (U.S. Patent No. 5,576,311). Claims 1-27 were rejected as allegedly being anticipated by WO02089815. Anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicants have amended the claims so that the phrase "delivering a therapeutically effective amount of a therapeutically active agent to a structure or combination of structures of the eye which include the vitreous humor and structures posterior to the vitreous" now reads "delivering a therapeutically effective amount of a therapeutically active agent to a structure or combination of structures of the eye selected from the vitreous humor and structures posterior to the vitreous humor." Apparently, the Office interpreted this to mean the composition delivered the therapeutically active agent to any structure in the eye. The claim now clearly limits the method to delivery of the therapeutically active agent to "the vitreous humor and structures posterior to the vitreous humor."

The Federal Circuit has held that to anticipate a method of treating an animal or human, the method must be carried out with the intent required in the claims: "[i]n other words, administering the claimed vitamins in the claimed doses for some purpose other than treating or preventing macrocytic-megaloblastic anemia is not practicing the claimed method, because Jansen limited his claims to treatment or prevention of that particular condition in those who need such treatment or prevention." *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1334 (Fed. Cir. 2003). Neither of the references teaches administration of the composition with the intent of delivering the drugs to the particular structures of the eye cited in the claims. Therefore, the claims are not anticipated.

35 U.S.C. § 103

No *prima facie* case of obviousness has been made. MPEP 2143 states that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." As pointed out above, carrying out a method with a specific intent is a real limitation that must be taught or suggested in the prior art to justify making an obviousness rejection. The Office has not even acknowledged the existence of the intent limitations, i.e. administering the

composition to deliver the therapeutically active agent "to a structure or combination of structures of the eye selected from the vitreous humor and structures posterior to the vitreous humor" (Claims 1 and 20), or "treatment of a disease or condition affecting the back of the eye" (Claim 19). Thus, a *prima facie* case of obviousness has not been made.

These claims are drawn to a method that was previously not considered to be possible in the art. Consider the following statement from a publication of a patent application that was filed in 2005 (US 2007/0020336) by Loftsson, who has several patents and publications regarding using cyclodextrins and cyclodextrin derivatives in pharmaceutical compositions.

> It is generally accepted that eye drops are ineffective and of little benefit in delivering drugs in therapeutic concentrations to the posterior segment of the eye (Myles et al 2005; Raghava et al 2004; Yasukawa et al 2005). Therefore various approaches have been developed where drugs are injected into the vitreous cavity (Jonas 2005), injected under the conjunctiva or tenon's capsule and various devices invented that may be introduced into the eye (Yasukawa et al 2005). All of these approaches are based on the premise that non-invasive topical methods to effectively deliver drugs, such as corticosteroids, to the posterior segment of the eye are not available, and invasive methods are the only alternative (Myles et al 2005; Raghava et al 2004; Yasukawa et al 2005; Beeley et al 2005).

Since the claimed method does what was even considered to be impossible even as late as 2005, there is no reasonable basis for believing that the claimed method was obvious at the time of filing in 2004. Applicants have shown that this conventional belief was wrong. This is the epitome non-obviousness.

In light of the amendments and the arguments made herein. Applicants believe that the claims are patentable as they now stand, and respectfully request that Examiner remove the rejections and allow the application to pass to issue.

Please use Deposit Account 01-0885 for extension of time fees or any other fees or credits relating to this response.

Respectfully submitted,

Date: February 23, 2007

/Brent A. Johnson/
Brent A. Johnson
Registration No. 51,851
Agent of Record

Please send all inquiries and correspondence to:
Brent A. Johnson
Allergan, Inc. (T2-7H)
2525 Dupont Drive
Irvine, CA 92612
Telephone: 714/246-4348
Telecopier: 714/246-4249